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Remarks/Arguments

In the 09/02/2004 Office Action, the following claims were rejected under the judicially created doctrine of double patenting:

Claims 1, 12, and 13 over claims 1, 28, and 29 of US 6,294,558.

Claims 1-15 over claims 1, 9, 10, and 11 of US 6,727,238.

Claims 1-15 over claims 1, 9, and 10 of US 6,608,095.

In the 09/02/2004 Office Action, claims 14-15 were rejected under 35 USC 102.

In the 09/02/2004 Office Action, claims 12 and 13 were rejected under 35 USC 101.

In the 09/02/2004 Office Action, claim 1 was rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the 09/02/2004 Office Action, claims 10 and 11 were objected to due to the number of compounds within the claims, citing Rule 141(a).

Double Patenting

Applicant will provide an executed terminal disclaimer for this pending application to US 6,294,558; US 6,727,238; and US 6,608,095 upon notification to Applicant that this pending application will be allowed in light of the other rejections and objections raised and addressed herein.

Claim Rejection under 35 USC 102

Applicant has canceled and deleted claims 12-15. Applicant reserves the right to file any deleted subject matter. Applicant requests withdrawal of this rejection.

Claim Rejection under 35 USC 101

Applicant has canceled and deleted claims 12-15. Applicant reserves the right to file any deleted subject matter. Applicant requests withdrawal of this rejection.

Claim Rejection under 35 USC 112

Variables A and R¹ were identified under the rejection based on 35 USC 112, second paragraph. From the rejection, it appears exception is taken with "partially saturated or unsaturated heterocycle or partially saturated or unsaturated carbocycle" and also possibly with

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"aryl" and "heteroaryl" in A and R¹. It further appears exception is taken with "optionally substituted" in variable R¹.

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants can be their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as **>any special meaning assigned to a term is clearly set forth in the specification. See MPEP 2111.01.< Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehardt*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. [MPEP 2173.01]

The MPEP, 2173.02 states:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. . . .

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
 - (B) The teachings of the prior art; and
 - (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
- [Emphasis in original.]

The terms: aryl, heteroaryl, partially saturated or unsaturated heterocycle, and partially saturated or unsaturated carbocycle are defined in the specification at page 5, line 20 to page 6, line 5. Applicant respectfully requests reconsideration of this rejection in light of these definitions. Applicant further requests withdrawal of this rejection with regard to the terms aryl, heteroaryl, partially saturated or unsaturated heterocycle, and partially saturated or unsaturated carbocycle.

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To the best of applicant's knowledge, the term "optionally substituted" is not specifically defined in the specification. Therefore, the term should be given its plain meaning. MPEP 2111.01. "Optionally substituted" is a term routinely used in patent law and no further explanation should be required. In light of the ordinary use of this term, Applicant believes that the term is clear. Furthermore, there are numerous examples in the pending case identifying substitution. Applicant respectfully requests Examiner Patel to review US 6,815,439, assignee SmithKline Beecham Corp., issued November 9, 2004 and on which Examiner Patel was the assistant examiner. Optionally substituted is used throughout this patent. See, for example, *inter alia*, variables R¹, R², R³ in column 5, lines 18-19 and lines 28-29. See also, *inter alia*, claim 10.

Applicant respectfully requests reconsideration of this rejection in light of these definitions. Applicant further requests withdrawal of this rejection.

Claim Objection

Claims 10 and 11 have been amended. Several compounds were deleted from both claims. Applicant reserves the right to file any subsequent application on the deleted subject matter. Furthermore, new claims were added with subject matter removed from claim 10 and placed into claims 16-20. Support for claims 16-20 is found in claim 10, which finds support in the specification from page 8, line 29 to page 20, line 7. No new subject matter was added with the new claims. To better identify which stricken subject matter was moved to claims 16-20, those stricken compounds are also bolded. Page/line references are to the attached Listing of Claims:

Species listed on page vii, lines 13-20 are in new claim 16.

Species listed on page xi, lines 17-20 are in new claim 17.

Species listed on page xi, lines 24-27 are in new claim 18.

Species listed on page xi, line 28 is in new claim 19.

Species listed on page xi, line 33 to page xii, line 6 are in new claim 20.

Typographical Error Correction

In preparing this response and amendment, a typographical error was identified. The letter "h" needs to be added to the compound in claim 10, page x, line 23. The letter is bolded

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and underlined to make it stand out. The substituent was inadvertently written as methoxymetyl and should read methoxymethyl. Page/line references are to the attached Listing of Claims.

Correspondence Address Change

A correspondence Address Change form is included herewith. Please send all future correspondence to the address associated with customer number 25533.

Conclusion

Applicant believes that the claims are in order for allowance, early notice of which is requested. If Examiner has any questions concerning this application, Examiner is invited to contact the below-signed attorney, who should have been added as an attorney associated with customer number 28523. It is believed that a no fee due. However, if there is a fee due, please charge any payment or credit any overpayment to Charge Account 21-0718.

Respectfully submitted,

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Date: 30 November 2004

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